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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,059	03/17/2004	Toshiya Nakayama	TAM-049	1695
20374	7590	05/11/2006		
KUBOVCIK & KUBOVCIK SUITE 710 900 17TH STREET NW WASHINGTON, DC 20006			EXAMINER RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,059

Applicant(s)

NAKAYAMA ET AL.

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Please note the examiner of record has been changed. The new examiner is Vickey Ronesi.
2. All outstanding rejections are withdrawn in light of applicant's arguments filed 2/28/2006.
3. New grounds of rejection are set forth below upon reconsideration of the prior art rejections of record. Thus, *a 3rd non-final Office action is set forth as follows.*

Claim Objections

4. Claims 1 and 5 are objected to because the phrase "the molded carrier being 1 to 5 seconds in average charge decay time for decay of 1,000 V to 5 V" is a little unclear. It is recommend that it read as "the carrier having an average charge decay of 1 to 5 seconds of from 1,000 to 5 V." Note that the term "the molded carrier" lacks full antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al (US 6,528,572).

Patel et al discloses a resin composition for use in chip carriers (col. 1, line 12) comprising a polymeric resin such as polyetheretherketone (col. 2, line 3), polyetherimide (col. 1, line 65), and polyether sulfone (col. 1, line 65) and a carbon fiber such as 0.25-30 wt % vapor grown carbon fibers having diameters of preferably 5.5-50 nm and an aspect ratio greater than or equal to about 100 (col. 3, lines 6-30) or 0.025-30 wt % carbon nanotubes having diameters of 2-50 nm and an aspect ratio greater than or equal to about 100 (col. 3, lines 31-52)—wherein the composition has improved electrostatic dissipation and the residual surface voltage of less than 5 volts when measured about 8 seconds after application of a charge greater than about 1000 volts (col. 1, lines 33-42).

With respect to new claims 5-7, they recite transitional claim language “consisting essentially of.” While it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. an antistatic agent, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03. Case law holds that “[i]f an applicant contends that additional steps or material in the prior art are excluded by the recitation of ‘consisting essentially of,’ applicant has the burden of showing that the

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introduction of additional steps or components would materially change the characteristics of applicant's invention." *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

While Patel et al does not specifically disclose or exemplify a chip carrier containing a composition comprising a synthetic resin as presently claimed and nanofibers as presently claimed, it is considered that it would have been obvious to one of ordinary skill in the art to utilize the presently claimed composition given that each of the ingredients are explicitly taught, absent surprising or unexpected results, and thereby obtain a composition having an average charge delay of 1-5 seconds after application of a charge of 1000 volts since Patel et al teaches the presently claimed composition and desirability of a short charge decay time.

Response to Arguments

6. Applicant's arguments filed 2/28/2006 have been fully considered but they are not persuasive. Specifically, applicant argues that unexpected results are had by the present composition which is shown in the inventive and comparative data of the specification as originally filed.

With respect to the argument, it is noted that the data is not commensurate in scope with the claimed invention. First, applicant only exemplifies PEEK and polyetherimide as the synthetic resin. Second, the inventive carbon black is a nanotube having an average diameter of 15 nm and a length of 0.2-2 microns, which provides for a carbon black having an aspect ratio of 13.3 to 1333 wherein a part of the range is outside the scope of the instant claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983).

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Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds). *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

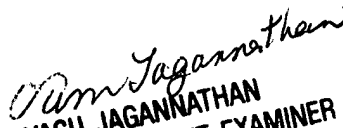
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/8/2006
Vickey Ronesi



VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
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